Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. MASSE
and JAMES R. ERICKSON

Appeal No. 95-1948
Application 08/090,854[1]

ON BRIEF

Before KIMLIN, GARRIS and WALTZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is the decision on an appeal from the final rejection of claims 1, 3 through 11 and 13 through 18 which are all of the claims remaining in the application.

The subject matter on appeal relates to a process of curing epoxidized polymers of conjugated dienes containing aromatic moieties by exposing the polymers to ultraviolet radiation in the

[1] Application for patent filed July 12, 1993.

presence of a photoinitiator which comprises reducing the amount of irradiation necessary to achieve an effective cure by adding to the polymer a photosensitizer that absorbs UV radiation in a wavelength range not obscured by the polymer. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

> 1. In a process of curing epoxidized polymers of conjugated dienes which contain aromatic moieties by exposing the polymers or a formulation containing such polymers to ultraviolet radiation in the presence of a photoinitiator, the improvement which comprises reducing the amount of irradiation necessary to achieve an effective cure by adding from 0.05 to 0.5 parts per hundred polymer of a photosensitizer which absorbs UV radiation in a wavelength range which is not obscured by the polymer to the polymer prior to or during irradiation.

The reference relied upon by the examiner as evidence of obviousness is:

Erickson et al. (Erickson) 5,229,464 Jul. 20, 1993

All of the claims on appeal stand rejected under 35 USC § 103 as being unpatentable over Erickson.[2]

We refer to the Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the appellants

[2] The appealed claims will stand or fall together as explained on page 2 of the Answer, and the appellants have not contended otherwise on the record before us.

and the examiner concerning the above noted rejection.

OPINION

This rejection will be sustained. Since we agree with the findings of fact, conclusions of law and responses to arguments set forth in the Answer, we will adopt these findings, conclusions and responses as our own. We add the following comments for emphasis and completeness.

The appellants argue that Erickson contains ?no example of a combination of a photoinitiator which absorbs in the same wavelength region as the aromatic moieties with a photosensitizer which absorbs in a different wavelength region? (Brief, page 4). This argument is unpersuasive for two reasons. In the first place, obviousness under § 103 simply does not require exemplification in a reference. In the second place, the independent claims on appeal do not require ?a combination of a photoinitiator which absorbs in the same wavelength region as the aromatic moieties with a photosensitizer which absorbs in a different wavelength region?.

The appellants also argue that ?there is no recognition of the problem which the present invention solves? (Brief, page 4). As pointed out above, however, the independent claims are not

limited to the features argued by the appellants and therefore do not appear to be limited to the problem/solution which the appellants have described in their specification. In any event, it is a well settled general rule that merely discovering and claiming a new benefit of an old process cannot render the process again patentable even when the claimed process may not be entirely old.[3] In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Finally, with regard to the appellants' general reference to ?unexpected improved results? (Brief, page 4), we point out that the record of this appeal contains no evidence that the results achieved by a process of the scope defined by the independent claims are different, much less unexpected, relative to the results achieved by the process of Erickson.

For the reasons set forth above and in the Answer, we hereby sustain the examiner's § 103 rejection of claims 1, 3 through 11 and 13 through 18 as being unpatentable over Erickson.

The decision of the examiner is affirmed.

[3] We here emphasize that the appellants have not contested in their Brief the examiner's obviousness conclusion with respect to the photosensitizer amounts defined by the independent claims on appeal.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

EDWARD C. KIMLIN Administrative Patent Judge	)
BRADLEY R. GARRIS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
THOMAS WALTZ Administrative Patent Judge	)

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